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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/051,670

09/08/98

NAKAGAWA

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FJN-063

HM22/1206

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EXAMINER

ROMEO, D

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

12/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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# Office Action Summary

Application No.  
09/051,670

Applicant(s)  
Nakagawa et al.

Examiner  
David S. Romeo

Group Art Unit  
1646



☒ Responsive to communication(s) filed on 20 Sep 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 5, and 6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 5 is/are allowed: <sup>able</sup>

☒ Claim(s) 1, 2, and 6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

### DETAILED ACTION

1. The amendment filed 09/20/99 (Paper No. 11) has been entered in full. Claims 1, 2, 5, and 6 are pending and are being examined.

2. Any objection or rejection of record that is not maintained in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *New formal matters, objections and/or rejections:*

3. Claims 1, 2, and 6 are not fully in compliance the sequence rules, 37 C.F.R. § 1.821-1.825. Specifically, 37 C.F.R. § 1.822(e), which states in part "A sequence that is made up of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence."

Correction is required.

#### *Claim Rejections - 35 USC § 112*

4. Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1646

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Claim 2 is indefinite over the recitation of "wherein SEQ ID NO:1 comprises ... residues 1173-1202 of SEQ ID NO:1" because the limitation "comprises ... residues 1173-1202 of SEQ ID NO:1" is broader than the limitation SEQ ID NO:1 and it is unclear whether SEQ ID NO:1 or only residues 1173-1202 of SEQ ID NO:1 is intended. Claim 2 is also indefinite on these same grounds over the recitation of similar language with respect to SEQ ID NO:2.

Claims 1, 2, and 6 are indefinite because the order of SEQ ID NO:1 and SEQ ID NO:2 in the DNA molecule are not clearly set forth. It is unclear if SEQ ID NO:1 precedes SEQ ID NO:2, if SEQ ID NO:2 precedes SEQ ID NO:1, or if both orientations/orders are intended. The metes and bounds of the claim(s) are not clearly set forth.

### *Conclusion*

5. Claim 5 is allowable.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1646

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Romeo whose telephone number is (703) 305-4050. The examiner can normally be reached on Monday through Friday from 6:45 a.m. to 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.

Faxed draft or informal communications should be directed to the examiner at (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Elizabeth C. Kemmerer*

ELIZABETH KEMMERER  
PRIMARY EXAMINER

dsr *ASR*  
December 1, 1999